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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/771,841

02/04/2004

Jessica Wang

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08/23/2004

SEED INTELLECTUAL PROPERTY LAW GROUP PLLC  
701 FIFTH AVE  
SUITE 6300  
SEATTLE, WA 98104-7092

EXAMINER

SAWHNEY, HARGOBIND S

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/771,841

Applicant(s)

WANG, JESSICA

Examiner

Hargobind S Sawhney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-18, 20-27 and 29-31 is/are rejected.
- 7) ☒ Claim(s) 19 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/14/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

1. The petition under 37 C.F.R. § 1.102 (d) filed on May 14, 2004 has been entered and granted. In addition, the preliminary amendment, filed on May 14, 2004 has been entered. Accordingly:

- The specification has been amended;
- Claims 1-4 have been canceled; and
- New claims 5-31 have been added.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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3. Claims 5-8,10,14,18, and 20-24 are rejected under the judicially created doctrine of double patenting over claims 1-4 of U. S. Patent No. 6,719,440 B1, since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Instant Application No. 10,771,841	U. S. Patent No. 6,719,440 B1	Discussion on differences, and additional References:
Claims 5-8 and 18	Claim 1	Claim 1, lines 1-8 meets the limitations of claims 5-8 and 18 of the instant application.
Claim 10	Claim 2	Substantially identical, Claim 2 meets the limitations of the claim 10 of the instant application.
Claims 11 and 14	Claim 4	Substantially identical, Claim 4 meets the limitations of the claims 11 and 14 of the instant application.
Claims 20-24	Claim 1	Claim 1 of U. S. Patent No. 6,719,440 B1 teaches the apparatus elements needed for meeting the method limitations of claims 20-24 of the instant application.

		It would be have been obvious to one of ordinary skill in the art at the time of the invention to apply the above-indicated teaching for meeting the method limitations of claims 20-24 of the instant application.
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It would be have been obvious to one of ordinary skill in the art at the time of the invention to meet the limitations of claims 5-8,10,14,18, and 20-24 with the claimed features of claims 1-4 of U. S. Patent No. 6,719,440 B1.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

This is a provisional obviousness-type double patenting rejection.

4. Claim 9 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U. S. Patent No. 6,719,440 B1 in view of Su (US patent No.: 6,769,954 B2).

Claim 1 of U. S. Patent No. 6,719,440 B1 claims a skeleton specifically profiled by gathering a plurality of rods, and a plurality of light bulbs mounted on the frame. However, Claim 1 of U. S. Patent No. 6,719,440 B1 does not specifically recites the plurality of light bulbs being positioned within the frame.

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On the other hand, Su ('954 B2) discloses a Christmas deer toy (Figure 5) including a plurality of light bulbs 15 (Figure 5, column 3, lines 33-36) positioned within the frame (Figure 5).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the formative light fixture of the instant application with a plurality of light bulbs positioned within the frame as taught by Su ('954 B2) for the benefits of illuminated artistic production for festival joy.

5. Claims 12,17,26, 27 and 29-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 1 of U. S. Patent No. 6,719,440 B1 in view of Chen et al. (US patent Application Pub. No.: US 2002/0121295 A1).

Regarding claims 12 and 17, Claim 12 of U. S. Patent No. 6,719,440 B1 claims a skeleton frame including refractive coating. However, Claim 1 does not specifically recites the refractive material being thready - of an elongated length-.

On the other hand, Chen et al. (US patent Application Pub. No.: US 2002/0121295 A1) discloses an illuminating device mounted on an umbrella (Figure 3) comprising refractive thread 212 positioned on a light emitting rod cover 21 (Figure 3, Para. 00032).

Thus, regarding claims 12 and 17, it would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the frame of U. S. Patent No. 6,719,440 B1 by providing refractive thread as taught by Chen et al. (US patent

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Application Pub. No.: US 2002/0121295 A1) for the benefits of novelty of bright refracted light for high value attraction.

Regarding Claim 26 of the instant application, the prior art U. S. Patent No. 6,719,440 B1 in view of Chen et al. (US patent Application Pub. No.: US 2002/0121295 A1) fulfills the needs for meeting the method limitations.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to apply the above-indicated teaching for meeting the method limitations of Claim 26 the instant application.

Regarding Claim 27, the prior art U. S. Patent No. 6,719,440 B1 in view of Chen et al. (US patent Application Pub. No.: US 2002/0121295 A1) meets the limitations in the similar manner as that discussed above for rejections of claims 5,12 and 17.

Regarding claims 29-31, U. S. Patent No. 6,719,440 B1 in view of Chen et al. (US patent Application Pub. No.: US 2002/0121295 A1) discloses an illuminating device mounted on an umbrella (Figure 3) comprising refractive thread 212 positioned on a light emitting rod cover 21 (Figure 3, Para. 00032). However, neither combined nor individual teaching of U. S. Patent No. 6,719,440 B1 and Chen et al. (US patent Application Pub. No.: US 2002/0121295 A1) specifically teaches the elongated thread being configured in random pattern, partially covering the frame, or in a scattered pattern.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to tint the refractive material with different color tints at different locations for ornamentation purpose, since it has been held that matters relating to ornamentation

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only which has no mechanical function cannot be relied upon to patentably distinguish the claimed invention over prior art.

6. Claims 13 and 25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U. S. Patent No. 6,719,440 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason.

Regarding Claim 13, although, Claim 4 of U. S. Patent No. 6,719,440 B1 claims the refractive layer being made of tinted transparent material, the claim does not specifically recites the tinted transparent material being tinted differently in different location for creation a colored pattern.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to tint the refractive material with different color tints at different locations for ornamentation purpose, since it has been held that matters relating to ornamentation only which has no mechanical function cannot be relied upon to patentably distinguish the claimed invention over prior art.

Regarding Claim 25, Claim 4 of U. S. Patent No. 6,719,440 B1 fulfills the needs for meeting the method limitations of Claim 25 of the instant application.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to apply the above-indicated teaching of Claim 4 for meeting the method limitations of Claim 25 the instant application.



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7. Claims 15 and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U. S. Patent No. 6,719,440 B1 in view of Pan (US patent No.: 5,850,927).

Regarding Claim 15, although, Claim 1 of U. S. Patent No. 6,719,440 B1 claims a skeleton specifically profiled by gathering a plurality of rods, the claim does not specifically recites a desired shape being an animal.

On the other hand, regarding Claim 15, Pan ('927) discloses a wire framework and light supporting display comprising a plurality of rods formed into a shape of an animal (Figure 1).

Regarding Claim 16, Pan ('927) additionally teaches the light supporting display that a three dimension figure other than an animal , including a plant or tree, also falls within scope of his invention (Figure 1, column 5, lines 6-13

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the formative light fixture of the instant application into either a plant (Christmas tree) or an animal shaped profile as taught by Pan ('927) for the benefits of seasonal decoration commonly used during festivals.

### ***Allowable Subject Matter***

Claims 19 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the

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limitations of the base claim and any intervening claims.

The prior art of record, including Pan (US patent No.: 5,850,927), Chen et al. (US patent Application Pub. No.: US 2002/0121295 A1) and Su (US patent No.: 6,769,954 B2), fails to show or suggest the applicant's invention as claimed. Specifically, the prior art of record does not disclose a decorative lighting fixture combining a light refracting material fused to the frame as recited in claims 19 and 28.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Pan (U.S. Patent No. 6,682,208 B1)

Onishi (U.S. Patent No. 6,413,594 B1)

Rinehimer (U.S. Patent No. 5,645,343)

Each of the above-indicated prior arts discloses a decorative light fixture assembly comprising some of the claimed features claimed by the applicant.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hargobind S Sawhney whose telephone number is 571-272-2380. The examiner can normally be reached on 6:15 - 2:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 571-272-2378. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703) 872-93067724 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2956.

HSS

August 15, 2004

A handwritten signature in black ink, appearing to read 'T. M. Sember', with a stylized flourish at the end.

THOMAS M. SEMBER  
PRIMARY EXAMINER